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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/625,803	07/26/2000	Robert A. Rabiner	11010/18	8247

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EXAMINER

MANTIS MERCADER, ELENI M

ART UNIT PAPER NUMBER

3737

DATE MAILED: 12/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/625,803

Applicant(s)

RABINER ET AL.

Examiner

Eleni Mantis Mercader

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) 1-16 and 29-48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-28 and 49-62 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 and 5. 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

I. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-16 and 29-41, drawn to ultrasonic cavitation of tissue, classified in class 601, subclass 2.

~~II. Claims 17-28 and 49-62, drawn to ultrasonic probe with irrigation, classified in class 606, subclass 169.~~

III. Claims 42-48, drawn to treating material in a wound, classified in class 604, subclass 46.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I, II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions they have different functions, different modes of operation and have different effects. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. Claims 1-16 and 29-41 pertain to ultrasonic cavitation of tissue to treat the prostate, causing destruction of tissue via cavitation. Claims 17-28 and 49-62 are drawn to an ultrasonic probe, which can be a cutting instrument and irrigation of debris. Claims 42-48 teach a method of applying hemostasis and treating a created cavity. All of these inventions are separate and distinct and require different searches.

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3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Because these inventions are distinct for the reasons given above and the search required for Groups I or II is not required for Group III, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Mr. David Dykeman on 11/8/2002 a provisional election was made with traverse to prosecute the invention of Group II, claims 17-28 and 49-62. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-16 and 42-48 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### ***Double Patenting***

7. Claims 17-24, 26-28, 49-58 and 60-61 of this application conflict with claims 1, 8 and 9 of Application No. 09/784,619. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the

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conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 17-24, 26-28, 49-58 and 60-61 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 8 and 9 of copending Application No. 09/784,619. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one skilled in the art based on the knowledge of skilled artisans to have used the ultrasonic probe with vibrations in its longitudinal axis as this is well known in using ultrasonic end-effectors in surgical procedures.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

#### ***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 17-24, 26-28, 49-58 and 60- 49 are rejected under 35 U.S.C. 102(b) as being anticipated by Hornlein et al.'790.

Hornlein et al.'790 teach all the features of the instant invention including an ultrasonic treatment apparatus having:

An ultrasonic probe having an ultrasonic tip, the ultrasonic probe including at least one channel on an outer surface of the ultrasonic probe, the at least one channel extending from the proximal end of the ultrasonic probe to a location adjacent the ultrasonic probe (see Figure 1; col. 6, lines 44-66; and also see Figures 4A and 4B; and col. 8, lines 9-42). The probe therefore includes a number of channels one of which spirals around the outer surface of the ultrasonic probe (see Figure 4A and 5 and in particular element 76). The ultrasonic probe includes an irrigation passage (in Figure 5 see element 89 and in col. 8, lines 51-60). The sheath of the probe, element 60 is depicted in Figure 3. The axial arrangement of the parts and their interconnections are depicted in Figures 3, 4A and 4B.

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 25 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hornlein et al.'790 in view of Silverstein et al.'525.

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Hornlein et al.'790 do not teach a fiberoptic endoscope having channels for insertion of treating tools including ultrasound therapeutic probe.

Silverstein et al.'525 teaches a fiberoptic endoscope having channels for insertion of treating tools including ultrasound therapeutic probe (see col. 8, lines 24-38; col.12, lines 50-68; and col. 13, lines 1-2).

It would have been obvious to one skilled in the art at the time that the invention was made to have modified Hornlein et al.'790 and included the teaching of Silverstein et al.'525 in inserting a fiberoptic through one of the channels in order to image the area of interest for monitoring purposes.

14. Claims 17-24, 26-28, 49-58 and 60- 49 are rejected under 35 U.S.C. 102(f)/103(a) as being unpatentable over Rabiner et al.'446 (application serial No. 09/784,619).

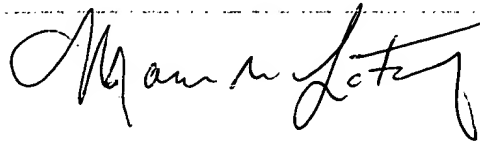
Rabiner et al.'446 teach all the features of the instant invention except for the ultrasonic probe with vibrations in its longitudinal axis. It would have been obvious to one skilled in the art based on the knowledge of skilled artisans to have used the ultrasonic probe with vibrations in its longitudinal axis as this is well known in using ultrasonic end-effectors in surgical procedures.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eleni Mantis Mercader whose telephone number is 703 308-0899. The examiner can normally be reached on Mon. - Fri., 8:00 a.m.-6:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marvin Lateef can be reached on 703 308-3256. The fax phone numbers for the organization where this application or proceeding is assigned are 703 305-3590 for regular communications and 703 308-0758 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-0858.



Marvin M. Lateef  
Supervisory Patent Examiner  
Group 3700



EMM  
December 15, 2002